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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,440

04/14/2004

Bruce Bent

049212-0102

8474

22428 7590 08/11/2009

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

08/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,440	Applicant(s) BENT ET AL.	
	Examiner JAGDISH N. PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-50,60-68,83 and 86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-50,60-68,83 and 86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/09,5/12/09,6/2/09,7/17/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 3/11/09.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/09 has been entered.

Response to Amendment

3. The Examiner notes that the Applicants by filing an RCE (date 5/12/09) subsequent to informing the office of a litigation proceeding (filed 4/2/09) have expressly requested that the application be examined at this time (and not suspended).

4. Amendment of claims 32, 35, 41, 43-45, 46, 47, 48, 49, 50, 60, 64, 65, 66, 67, 68, 83 and 86 is acknowledged.

5. Claims 32-50, 60-68, 83 and 86 are currently pending and have been examined. The following paragraphs outline issues raised by the Examiner.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 32-50, 60-68, 83 and 86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. The specification of the patent subject of reissue proceeding (Pat. 6374231) fails to describe the subject matter of claims 32 (and dependent claims 33-40) as follows:

depositing funds to or withdrawing funds from a single insured money market deposit account at a second banking institution based on the net transaction, with the withdrawing funds comprising withdrawing funds from the single insured money market deposit account at the second banking institution more than six (6) times during a month and transferring the funds to the first banking institution;

receiving by one or more computers interest from the second banking institution on funds held in said single insured money market deposit account;

The specification teaches that an administration system keeps all of the records for the client deposits and withdrawals and calculates the total of the deposits and withdrawals for all clients, and uses the calculation to determine whether funds are deposited to or withdrawn from a single deposit account in which all clients' deposit funds are kept. (abstract).

The specification Further teaches "The funds for all of the clients are pooled into a single fund that is maintained as an insured deposit account at a licensed banking institution. This system is preferably implemented in combination with a brokerage account so that the client can centralize all of his financial needs: deposit of funds; demand orders for payment (checking); payment authorization by debit card; securities transactions; retirement plans; and the like."

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The Examiner has carefully reviewed the specification and has not been able to identify any portion of the specification that teaches the arrangement whereby a first and second financial institutions collaborate to achieve the functionality of the claimed invention.

The Applicant is requested to provide detailed explanation for the support of the aforementioned features of the claimed invention.

The analysis provided in the foregoing paragraphs also apply to claims 41-50, 60-68, 83 and 86.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 32-50, 60-68, 83 and 86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 32 is exemplary claim analyzed. All independent claims should be review all independent claims for similar deficiencies.

Claim 32 recites "one or more computer" in multiple process steps with specifically pointing out if these one or more computers are distinct or interconnected.

Furthermore, the claim fails to point out any movement of funds as a result of a net transaction determination. It is unclear how the second banking institution receives any data pertaining to determination of the net transaction (which inherently occurs at the first banking institution).

It is requested that the claims be redrafted to point out the interrelationship of the "one or more computers" recited in individual process steps in terms of their data exchange. Furthermore, the exchange of specific parameters between the first and the second financial institutions be clearly stated.

Claims Rejections- 35 USC 251/Defective

- The patent subject to reissue proceeding has been assigned to DOUBLE ROCK CORPORATION and ISLAND INTELLECTUAL PROPERTY LLC. 37 CFR 1.172

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requires that all assignees owning an undivided interest consent to the filing of the reissue application. The application cannot be allowed without consent of all assignees.

- the Applicants have not provided explanation mapping out the differences between the new claims and patent claims. Referring p.11 under "REMARKS", the Applicant describes the amendment to various claims, however, there is no explanation pointing out the differences between the new claims and the patent claims.

- the reissue supplemental declaration filed 5/12/09 with the attached listing still does not identify at least one 35 USC 251 error being relied upon as a basis for reissue.

An example of a proper error is:

"The error is that I/We claimed more than we had right to claim, specifically it was error to include limitations that cover a .. in a single banking institution.. in Claim X .. while according to the invention defined in the current claims Y .. (describe the features of reissue claims)"

In other words the error statement must reference specific claims (by numbers) and pertinent limitations which are subject of reissue application.

- The amendment does not provide explanation of support in the disclosure of the new claims. The Applicant needs to map out each limitation of each claim and show where on the patent the limitation is supported.

Accordingly the pending claims stand rejected under 35 USC 251.

Conclusion

The Patent under reissue proceeding is involved in litigation. Accordingly a one (1) month reply period is set.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on Monday – Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693